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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91156321
Party	Defendant United States Hispanic Chamber of Commerce Foundation
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<p>In Re Application Serial No. 78/081,731 for U.S. HISPANIC CHAMBER OF COMMERCE FOUNDATION & Design</p> <p>THE CHAMBER OF COMMERCE OF THE UNITED STATES OF AMERICA,</p> <p>Opposer,</p> <p>vs.</p> <p>UNITED STATES HISPANIC CHAMBER OF COMMERCE FOUNDATION,</p> <p>Applicant.</p>	<p>Opposition No. 91-156,321</p> <p>APPLICANT'S OPPOSITION TO OPPOSER'S MOTION TO EXTEND TESTIMONY PERIOD</p>
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Applicant United States Hispanic Chamber of Commerce Foundation ("Applicant"), by and through its counsel, hereby opposes The Chamber of Commerce of the United States of America's ("Opposer") Motion To Extend Testimony Period.

Mere two months after fiercely opposing Applicant's similar Motion to Extend Testimony Period and urging the Board to "move the case forward," Opposer seeks a continuance of the remaining dates in this proceeding. Opposer's position taken in its motion directly contradicts Opposer's recent position. Opposer's speaking out of two sides of its mouth should not be rewarded by the Board. If the Board grants Opposer the requested 10-day continuance of the dates, Applicant requests that the Board similarly grant an extension to allow Applicant to finish its third-party testimony depositions.

Opposer's predicament with the subject third-party deposition is clearly self-inflicted. On February 19, 2008, Opposer received the allegedly misdirected letter sent

by National Hispanic Corporate Achievers, Inc. ("NHCA"). Knowing well that its rebuttal period will only be open between March 29, 2008 and April 28, 2008, Opposer waited for more than a month and a half to serve NHCA with a subpoena and set the deposition date for April 21, 2008, five business days before the last day of the testimony period. After the NHCA's deposition, Opposer decided to depose yet another third party, Hispanic Association for Corporate Responsibility ("HACR"), from whose website NHCA allegedly obtained the name, but not the address, for one of HACR's then board members, Michael Barrera.¹ Naturally, having delayed the NHCA deposition until almost the close of its rebuttal period, Opposer was left practically with no time to go chase more information, regardless of how useless it might be for Opposer's case, from a new third party.

It is noteworthy that before filing its motion, Opposer did not request Applicant to stipulate to an extension. Opposer's decision must have been dictated by the position taken by Opposer in its opposition, and in its letters to Applicant related, to Applicant's similar motion to extend. Specifically, in no less than ten letters that Opposer sent to Applicant on February 19, 2008, which, ironically, is the day when Opposer received the allegedly misdirected letter to Michael Barrera, Opposer included the following strict warning to Applicant:

As it would be improper for Applicant to take trial testimony outside of its testimony period, *see* TBMP §707.03(b), 37 CFR §2.121(a), the U.S. Chamber will object to any testimony taken after February 28th unless the Board first agrees to extend the period. Specifically, the U.S. Chamber will move to quash any subpoena that seeks to compel a third part [sic] to appear for a deposition

¹ The NHCA corporate representative, Daniel Ramos, deposed by the parties on April 21, 2008 did not have any information regarding the source of the incorrect address for Michael Barrera. Responding to Applicant's counsel's question whether the incorrect address was obtained from the HACR website, Mr. Ramos stated: "I don't know because I don't know if the addresses were there [on the HACR website] or not. You know, I just gave them [the NHCA volunteers who assembled the envelope for Michael Barrera] the assignment and they might have dug up the addresses based upon going on the internet. I really don't know." Declaration of Andrew Eliseev ("Eliseev Decl.") ¶ 2, Ex. A.

after the February 28th cut-off date, and will move to strike any late testimony taken voluntarily.

(Eliseev Decl. ¶ 3, Ex. B.)

Opposer was thus quite clear about its intention to impede any effort on Applicant's part to take a third-party testimony deposition outside of Applicant's testimony period. As explained in detail in Applicant's motion to extend, Opposer's ten baseless motions to quash filed in three federal courts were purposely geared to delay and obstruct Applicant's third-party testimony depositions. When Applicant wanted to take several depositions after the close of its testimony period, Opposer was unyielding in its determination not to stipulate to any extensions and strongly opposed the Applicant's motion for an extension. Opposer's opposition to that motion was full of pleas to the Board to deny Applicant's request and "allow this case to move forward" "for one simple reason: [Applicant] failed to act in a diligent manner when putting on its case" (Docket No. 54, pp. 6 and 7.)

It is both instructive and ironic that after taking such a self-righteous stand in its opposition to Applicant's motion for an extension, Opposer waited seven weeks² before serving its subpoena on NHCA and scheduling its deposition during the last week of its 30-day rebuttal period. Not surprisingly, Opposer's motion is silent on the issue of Opposer's delay. But for that delay, Opposer would almost certainly be able to depose HACR before the close of Opposer's rebuttal period, thus obviating the need for an extension.

HACR's deposition took place on May 2, 2008. Without waiving the objection to the untimeliness of the deposition, Applicant's counsel attended it and cross-examined HACR's representative. The deposition was taken outside Opposer's rebuttal period,

² Opposer tries to distinguish its motion from Applicant's motion to extend based on the time to act with respect to the third-party depositions, but it is unavailing. First, Applicant's testimony period was not open for seven months before Applicant served its subpoenas, as Opposer contends. Second, Applicant immediately contacted the third parties when its testimony period opened.

without the parties' stipulation approved by the Board, and without a Board order allowing the deposition to take place outside of Opposer's rebuttal period. Pursuant to TBMP § 707.03(b)(1), the deposition must be stricken.

If the Board decides to grant Opposer's motion and legitimize the HACR deposition, it would be immensely unfair to Applicant if the Board denies its recent motion for an extension and precludes Applicant from taking several remaining third-party testimony depositions outside Applicant's testimony period.

CONCLUSION

The Board should deny Opposer's motion. However, should the Board grant the motion, Applicant respectfully requests that the Board similarly grant a 60-day extension to allow Applicant to complete its remaining third-party testimony depositions.

Respectfully submitted,

Date: May 19, 2008

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CERTIFICATE OF ELECTRONIC TRANSMISSION

I hereby certify that this correspondence is being transmitted electronically through ESTTA pursuant to 37 C.F.R. § 2.195(a), on this 19th day of May, 2008.

/s/Paulette E. Surjue
Paulette E. Surjue

CERTIFICATE OF SERVICE

I hereby certify that the foregoing document has been served upon the attorney for Applicant by depositing a copy thereof in an envelope addressed to: Erik Kane, Kenyon & Kenyon, 1500 K Street, N.W., Washington, DC 20005-1257, on this 19th day of May, 2008.

/s/ Paulette E. Surjue
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